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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,903	11/13/2003	Kazuyuki Ozai	A36085 - 070793.0155	9437
21003	7590	12/14/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MAYO III, WILLIAM H	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,903

Applicant(s)

OZAI ET AL.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in present Application No. 10/712,903, filed on November 13, 2003.

### ***Specification***

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because in lines 10-13 the abstract refers to purported merits or speculative applications of the invention. The applicant

should delete the lines to provide the abstract with clarity. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claims 4 and 6-7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Treatment of Claims***

7. The examiner assumes that the dielectric member must comprise a material selected from a group consisting of porous resin materials.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (Pat Num 4,923,410). Suzuki discloses cable connecting structure (Figs 1-4) for an electrical connector (11) for connecting a cable (9) including cable cores (104 & 114) each comprising a core conductor (104) and a core sheath (114) to respective contacts (31) of the electrical connector (11) having exposed core conductors (104, Fig 4) of the cable cores (104 & 114) by removing the leading end of the cable (9) thereby having a controlled characteristic impedance, a low level of loss, and a level of crosstalk (Col 1, lines 33-35). Specifically, with respect to claim 1, Suzuki discloses a cable connecting structure (Fig 1) comprising a dielectric member (top and bottom 51) having air (at 71) arranged to cover at least part of the exposed portions of the cable cores (104) of the cable (9, Col 5, lines 16-18). With respect to claim 2, Suzuki discloses that the dielectric member (top and bottom 51) has a dielectric constant of 1.5-4.5 (i.e. 1-2, Col 5, lines 23-29). With respect to claim 3, Suzuki discloses that dielectric member (top and bottom 51) is arranged to cover at least the core conductors (104) of the exposed portions of the cable cores (104) of the cable (9, Col 5, lines 16-18). With respect to claim 4, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material selected from a group consisting of porous resin materials (i.e. porous resin PTFE, Col 3, lines 55-65). With respect to claim 5, Suzuki discloses that dielectric member (top and bottom 51) is arranged to cover at least the core conductors (104) of the exposed portions of the cable cores (104) of the cable (9, Col 5, lines 16-18). With respect to claim 6, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material selected from a group consisting of porous resin materials (i.e.

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porous resin PTFE, Col 3, lines 55-65). With respect to claim 7, Suzuki discloses that the dielectric member (top and bottom 51) is made of a material selected from a group consisting of porous resin materials (i.e. porous resin PTFE, Col 3, lines 55-65). With respect to claim 9, Suzuki discloses that the dielectric member (top and bottom 51) is provided by embracing at least part of the exposed portions of the cable cores (104) of the cable (9, Fig 4) between two sheets (top and bottom 51) of porous resin material (i.e. porous PTFE, Col 5, lines 40-47).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (Pat Num 4,923,410). Suzuki discloses cable connecting structure (Figs 1-4) for an electrical connector (11) for connecting a cable (9) including cable cores (104 & 114) each comprising a core conductor (104) and a core sheath (114) to respective contacts (31) of the electrical connector (11) having exposed core conductors (104, Fig 4) of the cable cores (104 & 114) by removing the leading end of the cable (9) thereby having a controlled characteristic impedance, a low level of loss, and a level of crosstalk (Col 1, lines 33-35) as disclosed in claims 1 & 4 above.

However, Suzuki doesn't necessarily disclose the dielectric member composed of a sheet of porous resin being winded around the exposed conductor (claim 8).

With respect to claim 8, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the two sheets of dielectric member to comprise a unitary sheet wrapped around the exposed conductors since it has been held that forming in one piece an article which has been formerly been formed in two or more pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S> 164 (1893).

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are Kropa et al (Pat Num 6,354,878), Wolfel (Pat Num 4,516,822), Gutter (Pat Num 4,927,388), Stefaniu et al (Pat Num 6,793,537), Davis (Pat Num 5,766,025), Mizuno (Pat Num 4,815,981), Jean (Pat Num 4,188,714), Diaz (Pat

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Num 4,413,028), Hill et al (Pat Num 4,443,657), and Fritz et al (Pat Num 4,149,026), all of which disclose various cables and connectors.

### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William H. Mayo III  
Primary Examiner  
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WHM III



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December 8, 2004